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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,459	11/21/2003	Terry L. Harris		4149

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EXAMINER

GOTTSCALK, MARTIN A

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/719,459	Applicant(s) HARRIS, TERRY L.	
	Examiner Martin A. Gottschalk	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20031121</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: abstract and specification are replete with typographical errors. Particularly, the letter "o" is frequently missing from words (see abstract, lines 1 and 2); punctuation errors are found throughout (e.g. abstract, line 11, extraneous semi-colon; page 6, line 12, extra period after second sentence); and spelling errors are present (e.g. page 6, lines 17 and 19). Appropriate correction is required.

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because the abstract is not limited to a single paragraph. Correction is required. See MPEP § 608.01(b).

Claim Objections

3. Claim 6 is objected to because even though it appears it is intended to be a dependent claim, it fails to clearly identify the claim from which it depends, thus rendering it indefinite. Appropriate correction is required.

From context, it is inferred that claim 6 is intended to depend from claim 5. For the purpose of completing this examination, this will be assumed to be the case.

Claim Rejections - 35 USC §101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

5. Claims 1-10 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

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phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

A. In the present case, exemplary claim 1 only recites an abstract idea. Claim 1 is directed to "a system for establishing health care services " comprising the steps of "accessing a consumer..."; "accessing a medical service provider..."; "accessing a hospital..."; "accessing an insurance company..."; and "providing a consumer.." but does not recite any technological device by which the above steps are implemented. These steps do not apply, involve, use, or advance the technological arts, since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to gather the various participants of a health care service.

B. Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention results in providing a schedule of available services to a consumer, and thus has practical application, howbeit, not a practical application in the technological arts.

C. As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

In the present case, claims 1-10 recite the term "system" in their preamble only. Without a positive and definite recitation of technology within the body of the claims, this term does not require technology, per se, and is insufficient to render the claims statutory.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claim 1 recites, "A system for establishing health care services comprising the steps of..." It is not clear from this wording whether or not a system comprising components, or a method comprising steps is trying to be claimed, hence the claim is regarded as indefinite. Since all subsequent claims ultimately depend from this claim, they are also considered to be indefinite.

If it is inferred correctly that claim 1 was intended to be directed to a method, then the word "system" in the preamble of claim 1 should be replaced by "method". All of the subsequent claims 2-9 can be dealt with similarly.

For the purpose of the rest of this examination, it will be assumed that this is how the claim was intended to be construed.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Joao, Pat. No. 6,283,761 (hereinafter Joao).

A. As per claim 1, Joao discloses a method for establishing health care services comprising the steps of:

accessing a consumer to describe option-based health care services,
accessing a medical service provider to obtain a schedule of available medical services,
accessing a hospital to obtain a schedule of available hospital services,
accessing an insurance company to obtain a schedule of available insurance services,

providing a consumer with a schedule of available medical services and a schedule of available hospital services.

The apparatus and method of Joao comprises a processing system which incorporates data from (col. 12, lines 22-43), and provides information to (col. 11, line 66 through col. 12, line 1) a plurality of participants in the healthcare and related fields.

These participants include patients and those seeking healthcare (col. 12, line 51-57; i.e. "consumers"); healthcare providers, or providers of healthcare services (i.e. "medical service providers" including a "hospital," col. 13, line 56); and insurance companies (col. 13, lines 8-19; also called a "payer").

The system further comprises the components of FIG. 1, which shows communication devices for patients, providers, payers, and intermediaries connecting to a central processing computer. The central processing computer and said devices can transmit and receive information from each other in a bi-directional manner (col. 14, line 59 through col. 15 line 5). Said central processing computer includes a database(s) which contains data and/or information pertaining to the patients, providers, payers, and intermediaries who are serviced by, or who utilize the present invention (col. 16, lines 33-37).

The invention of Joao further enables any patient, user, provider, payer, and/or intermediary to be notified of the availability of a provider, the emergence of a patient in need of a certain care, the availability of an insurance company to offer a policy or a certain policy, and the availability of a healthcare facility to provide certain care (col. 31, line 1 through col. 32, line 5).

Thus the above participants who provide information for and use the described system, can be said to be "accessing" each other to obtain information, as well as to be "providing" information about the services available (see also col. 30, lines 61-63).

B. As per claim 2, the method of Joao further comprises the steps of:

preparing a medical services fee schedule in report form for a consumer and an insurance company,

preparing a hospital services fee schedule in report form for a consumer and an insurance company.

Joao teaches a system and method that will process a request for healthcare service and identify one or more providers along with their backgrounds, insurance coverage accepted, and fees (col. 30, lines 63-66). Following this, the central processing computer can generate a provider report and transmit the results (col. 31, lines 2-3) to a recipient(s). The provider can also be a "facility" (col. 31, lines 8-10), said facility being construed by the Examiner to include a hospital.

As indicated in previous paragraphs, the recipients of said report(s) can be any of the participants utilizing the system, including a consumer and/or an insurance company.

C. As per claim 3, the method of Joao further comprises the step of:

preparing an insurance company rate schedule in report form for a consumer.

In a similar manner to that described above in the rejection of claim 2, the system disclosed by Joao can be utilized to find a payer or insurance company for providing the desired coverage and/or for paying for certain treatments and/or procedures. The patient (consumer) accesses that central processing computer and provides information regarding the coverage needed. The central processing computer will process the request and identify one or more payers along with information about the payer or payers, and can then generate a payer report and transmit same to the patient (col. 31, lines 46-58). Because the system database contains the pertinent information, said report can include insurance company rates in the form of "premiums" (col. 33, lines 29-32); "reimbursement rates" (col. 17, line 67); and/or "co-payment information" (col. 18, line 4).

D. Claim 4 recites the following:

The system for establishing health care services according to Claim 3 further comprising:

determining a fee schedule of medical services fees and hospital services fees according to the option of the consumer and acceptable to an insurance company, and
determining a fee from an insurance company rate schedule according to the option of the consumer and acceptable to an insurance company, said fee to be described as an indemnity product.

The Examiner interprets this to mean that the consumer is narrowing down the choices of fees for services and insurance rates from a plurality of the same provided

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earlier, in order to make a final selection and consummate a transaction. As such, the teachings of Joao apply as follows.

Joao defines a "requesting party" (col. 32, 11-13) and a "supplying party" (col. 32, lines 20-27) requesting and supplying for instance, a type of healthcare service or an insurance policy (col. 32, lines 1-10). The requesting party submits the request to the central processing computer using the communication device of FIG 1. The supplying party or parties identify the request as one they wish to satisfy, and using their corresponding communication device, indicate this to the central processing computer, which sends a notifying communication to the requesting party of the response(s). The communication can include information for bringing the parties together "to act towards effecting and/or consummating the transaction" (col. 32, lines 28-37). It would be apparent to one of ordinary skill in the art at the time of the invention that such a consummation would include the determination of a fee acceptable to both parties.

E. As per claim 5, Joao discloses a method comprising the step of:

establishing a line of communication between a consumer and an insurance company for said indemnity product.

As stated earlier in the rejection of claim 4 and incorporated herein, Joao teaches a method of establishing communication geared towards bringing requesting (e.g. consumer) and supplying (e.g. insurance company) parties together so as to satisfy the need of the requesting party with the goods or services of the supplying party.

F. As per claim 6, the system disclosed by Joao further comprises:

an information media providing means for:

accessing a consumer,

accessing a medical services provider,

accessing a hospital, and

establishing a line of communication between a consumer and an insurance company for communicating an indemnity product.

As noted above in the rejection of claim 1 and incorporated herein, FIG. 1 in Joao shows communication devices (i.e. "information media") whereby patients (i.e. consumers), providers (i.e. including hospitals), and payers (i.e. insurance companies), all connected to a central processing computer, can be accessed. Furthermore, Joao states that, "the Internet and/or the World Wide Web is a preferred communication system and/or medium utilized," by the invention, but adds that it, "...can also be utilized with any appropriate communication network or system including..." and then goes on to recite a plurality of electronic networks and systems (col. 15, lines 25-47).

G. As per claims 7-10, as noted above in the rejection of claim 6 and incorporated herein, the system of Joao discloses

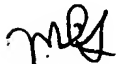
an information media providing means for establishing a line of communication between a consumer and an insurance company for communicating said indemnity product.

Conclusion

10. The Information Disclosure Statement filed 11/21/03 contains a reference (Document# 2002/0065759 A1) attributed to inventor Henley. As best as could be determined by the Examiner, the document should be attributed to Boies et al. This was noted on the Information Disclosure Sheet.
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not relied upon prior art teaches electronic systems linking information from various participants in health-care delivery (US Pat# 6,735,569; 6,012,035; 6,757,898; and US Pub# 2004/0002924).
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is 703-305-5356. The examiner can normally be reached on Mon - Fri 8:30 - 5.
13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

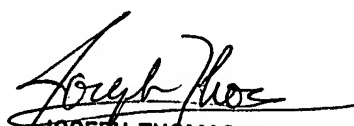
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